

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated November 6, 2006 (hereinafter Office Action) have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the prior art rejections (§§102(e) and 103(a)) based at least in part on the teachings of U.S. Patent No. 6,658,231 to Nakatsuyama (hereinafter "Nakatsuyama") because Nakatsuyama does not teach or suggest each of the purported claim limitations. For example, Nakatsuyama does not teach the limitations directed to "a content item" because the asserted "index data" of Nakatsuyama does not correspond to the claimed content item. The claimed content item is related to the content of a broadcast media stream and provides a supplementary service (*e.g.*, program information, reports, competitions) delivered in addition to a traditional media stream and presented to a user during the broadcast of the traditional broadcast media stream. *See, e.g.*, paragraphs [0024] and [0027] in the Specification. In contrast, Nakatsuyama's index data merely enables a receiver to receive and output selected programming. *See, e.g.*, column 5, lines 59-62 and column 7, lines 63-65. The index data is unrelated to the content of any associated programming. In accordance with MPEP §2111.01, Applicant is entitled to be his own lexicographer, and the Examiner has not shown how the asserted index data of Nakatsuyama corresponds to the claimed content item. This lack of correspondence is further illustrated by the improper rejection of dependent Claims 8 and 18 where the Examiner fails to identify how the tuning data (index data) of the cited portion at column 9, lines 48-67 is at least one of a text, an audio, a video, an image, and a multimedia presentation.

Moreover, there is no teaching in Nakatsuyama that the index data is presented to a user during the output of the selected programming. The relied-upon portion at column 2, lines 52-64 teaches only that index data is received; the only received signal that is presented is the requested programming. Without a presentation of correspondence to each of the claimed limitations, the prior art rejections are improper.

With particular respect to the §102(e) rejection, Applicant notes that in order to anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. §102. Applicant respectfully submits that Nakatsuyama does not teach every element of independent Claims 1, 11 and 21 in the requisite detail, and therefore fails to anticipate Claims 1-4, 6, 8-14, 16, 18-24 and 26.

Further, dependent Claims 2-4, 6, 8-10, 12-14, 16, 18-20, 22-24 and 26 depend from independent Claims 1, 11 and 21, respectively, and also stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Nakatsuyama. While Applicant does not acquiesce with the particular rejections to these dependent claims, the rejections are also improper for the reasons discussed above in connection with independent Claims 1, 11 and 21. These dependent claims include all of the limitations of independent Claim 1, 11 and 21 and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2-4, 6, 8-10, 12-14, 16, 18-20, 22-24 and 26 is improper. Applicant accordingly requests that the §102(e) rejection be withdrawn.

Applicant respectfully traverses the §103(a) rejection of Claims 5 and 15 based in part upon U.S. Patent No. 7,054,653 to Jarvi *et al.* (hereinafter “Jarvi”) because Jarvi is not an available reference for §103(a) rejections in view of 35 U.S.C. §103(c). Section 103(c) indicates that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. §102 shall not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. MPEP §706.01(l)(1). First, Jarvi is not available as a reference under

§102(a) or (b) because the first publication date of Jarvi (April 10, 2003) is later than the effective filing date for Claims 5 and 15, which is December 16, 2002. Jarvi is also not available as a reference under §102(c) or (d). Thus, Jarvi must be asserted based upon §102(e), (f), and/or (g).

Second, Jarvi is owned by Nokia Corporation as a result of the assignment recorded at Reel/Frame No. 012234/0945 on October 4, 2001, and the inventors of the instant invention were subject to an obligation to assign the instant invention to Nokia Corporation at the time the invention was made. That obligation was fulfilled as evidenced by the assignment of the instant application to Nokia Corporation recorded at Reel/Frame No. 016011/0345 on May 13, 2005. In view of the above-evidenced common ownership, Jarvi is not available as a §103(a) reference thereby rendering the §103(a) rejection improper. Applicant accordingly requests that the rejection be withdrawn.

Similarly, Applicant respectfully traverses the §103(a) rejection of Claims 7, 17 and 25 based in part upon U.S. Patent No. 6,678,510 to Syrjarinne *et al.* (hereinafter "Syrjarinne") because Syrjarinne is not an available reference for §103(a) rejections in view of 35 U.S.C. §103(c). Syrjarinne is not available as a reference under §102(a) or (b) because the first publication date of Syrjarinne (August 8, 2002) is later than the effective filing date for Claims 7, 17 and 25, which is April 22, 2002. Syrjarinne is also not available as a reference under §102(c) or (d). Moreover, Syrjarinne is owned by Nokia Mobile Phones Ltd. as a result of the assignment recorded at Reel/Frame No. 012487/0487 on January 15, 2002, and the inventors of the instant invention were subject to an obligation to assign the instant invention to Nokia Corporation at the time the invention was made. That obligation was fulfilled as evidenced by the assignment of the instant application to Nokia Corporation recorded at Reel/Frame No. 016011/0345 on May 13, 2005. In view of the above-evidenced common ownership, Syrjarinne is not available as a §103(a) reference thereby rendering the §103(a) rejection improper. Applicant accordingly requests that the rejection be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art,

obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.152US) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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